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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of L. Leonard Hacker

Serial No.: 09/525,244 Group Art Unit: 3626
Filed: 03/15/2000 Examiner: Morgan, R.

For: **PATIENT-CONTROLLED MEDICAL INFORMATION SYSTEM AND
METHOD**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

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Enclosed please find the following:

1. Reply Brief; and
2. Certificate of Express mailing.

The Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 18-1579. The Commissioner is also authorized to charge Deposit Account No. 18-1579 for any future fees connected in any way to this application. Two copies of this letter are enclosed.

Respectfully submitted,

Christopher B. Kilner
Registration No. 45,381
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191
(703) 391-2900

APPELLANT'S REPLY BRIEF
U.S. Application No. 09/525,244

#10/Reply Brief
L.E.
10-23-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Serial No.: 09/525,244 Group Art Unit: 3626
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For: **PATIENT-CONTROLLED MEDICAL INFORMATION SYSTEM AND
METHOD**

REPLY BRIEF

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Dear Sir:

Applicant hereby submits this Reply Brief in response to the Examiner's Answer of August 12, 2003. This submission is timely since October 12, 2003 was a Sunday and October 13, 2003 was a Federal Holiday (Columbus Day observed).

Respectfully submitted,



Christopher B. Kilner, Esq.
Registration No. 45,381
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191-5302
(703) 391-2900

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In re Application of L. Leonard Hacker

Serial No.: 09/525,244 Group Art Unit: 3626

Filed: 03/15/2000 Examiner: Morgan, R.

For: **PATIENT-CONTROLLED MEDICAL INFORMATION SYSTEM AND
METHOD**

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

Mail Stop Appeal Brief - Patents
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P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b)(1), Appellant requests withdrawal of the final rejection and submits the following:

Appellant hereby affirms that items I- VI of, and the Appendix to, the Brief on Appeal filed May 23, 2003 remain the same. It is Appellant's understanding that there is no need to reiterate contentions and information which were set forth in the Brief on Appeal. See 62 Fed. Reg. 53,132, 53,169 (1997) ("Contentions (or information) set forth in a previously filed appeal (or reply brief) need not be reiterated in a reply brief or supplemental appeal brief."). Item VI, Grouping of the Claims, is correct as stated in the Examiner's Answer.

VIII. ARGUMENTS

Claim Rejections - 35 USC §103

Claims 1-2, 5-9, 14, 19-20, 23-27, 32, and 37-44 were rejected as being obvious over Evans in view of Moshfeghi et al. Claims 3-4, 15, 21-22, and 33 were rejected as obvious over Evans in view of Moshfeghi et al. and further in view of Surwit et al. Claims 10 and 28 were rejected as obvious over Evans in view of Moshfeghi et al. and further in view of Edelson et al. Claims 11-13 and 29-31 were rejected as obvious over Evans in view of Moshfeghi et al. and further in view of Ross, Jr. et al. Claims 16 and 34 were rejected as obvious over Evans in view of Moshfeghi et al. and further in view of Lavin et al. Claims 17, 32, and 45-46 were rejected as obvious Evans in view of Moshfeghi et al. and further in view of Official Notice. Claims 18 and 36 were rejected as obvious over Evans in view of Moshfeghi et al. and further in view of Chou et al.

A common thread among all of these rejections is their dependence upon the combination of Evans in view of Moshfeghi et al. Appellant's consistent position has been that the applied combination of Evans in view of Moshfeghi et al. fails to make a *prima facie* case of obviousness and that the further-applied references fail to make up for the deficiencies of Evans and Moshfeghi et al.

In the "Response to Argument" of the Examiner's Answer, the examiner cites numerous legal precedents, but fails to properly address the basic legal issues raised by the Appellant.

APPELLANT'S REPLY BRIEF
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First, as per M.P.E.P. 2141.02, a prior art reference must be considered as a whole, *including portions that would lead away from the invention. W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed Cir. 1983). As previously submitted by Appellant, access limitations based on the patient ID, as taught by Moshfeghi et al., has little or no bearing on what entity controls and makes these access decisions. Both Evans and Moshfeghi et al. subscribe to the prior art teaching of having the medical establishment (i.e., hospital) control this aspect of the medical information, whereas the present invention allows the patient to control this aspect of his/her medical information. Indeed, both Evans and Moshfeghi et al. *teach away* from patient-controlled access as reasonably interpreted in a manner consistent with the specification (see M.P.E.P. 2111). Although the examiner apparently believes that patient-dependent access is somehow the same as patient-controlled access, this interpretation is erroneous and not consistent with Appellant's specification.

This erroneous interpretation by the examiner of either the claim language or the prior art is clearly reflected in the examiner's arguments on page 17 of the Examiner's Answer, wherein the examiner submits "that Evans is directed to a system that provides several levels of security for access to patient data and ensuring patient confidentiality (Evans; column 15, lines 21-24), and Moshfeghi discloses a system wherein user privileges and *access control to patient data is patient dependent* (Moshfeghi, column 6, lines 61-62). As such, the Examiner respectfully submits that the proper combination of the above teachings would be a system that provides levels of security for patient access to patient data that is based solely, on patient preferences

APPELLANT'S REPLY BRIEF
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(i.e., is "patient selected/controlled"). One having ordinary skill in the art at the time that the invention was made would clearly recognize that typically patient preferences with regard to medical information would vary according to different occupations/specialties as well as the nature of relationship between the patient and the medical service provide (see: Moshfeghi; column 5, lines 27-35). As such, the patient's preferences regarding her/his personal medical information would be based on various portions (or layers/levels) of information, and not on the total medical information record, per se." (Italics added for emphasis).

As is clear from the examiner's arguments above, the examiner's position depends on the erroneous leap from "patient dependent" access to "patient preferences," which are equated with being "patient selected/controlled." As previously submitted by Appellant, patient dependent access is not the same as patient control of access with means for patients to allow access to patient-selected portions of their medical record.

For precisely this reason, Appellant further reiterates that the *prima facie* case fails because all limitations are not found in the prior art, as previously submitted.

In addressing these arguments in the Examiner's Answer (see "Response to Argument B"), the examiner takes a position *for the first time* on page 18 that certain claim limitations fail to meet the requirements of the 35 USC 112 ¶6 in order to ignore the Appellant's arguments based upon these limitations not being found in the applied prior art. Appellant submits that the examiner's position is a new grounds of rejection prohibited by M.P.E.P. 1208.01 and is erroneous in not properly interpreting the claim limitations under 35 USC 112 ¶6.

IX. CONCLUSION

For the above reasons, Appellant respectfully submits that the Final Office Action of January 23, 2003 and Examiner's Answer of August 12, 2003 have failed to make out a *prima facie* case of obviousness with regard to claims 1-46, and therefore asks that the obviousness rejections be reversed.

The present Reply Brief is being filed in triplicate.

Appellant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 18-1579.

Respectfully submitted,



Christopher B. Kilner
Registration No. 45,381
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive
Suite 1000
Reston, VA 20191
(703) 391-2900

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Date of Deposit: October 14, 2003

I hereby certify that the Reply Brief for the patent application of L. Leonard Hacker for a **PATIENT-CONTROLLED MEDICAL INFORMATION SYSTEM AND METHOD**, Serial No. 09/525,244 is being deposited with the United States Postal Service for "Express Mail" service under 37 C.F.R. § 1.10 on the date indicated above and are addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450



Christopher B. Kilner
Registration No. 45,381
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive
Suite 1000
Reston, VA 20191